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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,734	08/03/2001	Norman Yamamoto	310048-650	8752

7590

08/14/2002

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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

**Office Action Summary**

Application No.

09/921,734

Applicant(s)

YAMAMOTO ET AL.

Examiner

Mark T Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-22 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3722

## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 7, 11, 17, 21 and 22 have been amended for examination. Claims 23 and 24 have been added.

Art Unit: 3722

***Election/Restriction***

2. Applicant's election with traverse of Group I, Claims 1-6 and 11-22 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the inventions are not independent and distinct. This is not found persuasive because the method claims 7-10 are distinct since the product can be made materially by another and materially different process. In the method claims, the applicant has disclosed a method of "bonding a pocket", wherein the specification discloses on page 6, par. 26, that the pocket is "heat formed (a form of bonding) into its formed position" on the front cover. In this instant case product can be made by another process of bonding such as stitching or stapling.

The requirement is still deemed proper and is therefore made FINAL.

3. Newly submitted claim 23 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the method of providing an image on a computer monitor can be done using various computer drawing software packages or displaying an image previously scanned in the computer (such as Internet images).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 23 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Art Unit: 3722

*Drawings*

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "22" has been used to designate both an "inner pocket" and a "cover". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "46" has been used to designate both a "tab" and a "transparent index sheet". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "52" has been used to designate both a "pocket"; a "pocket portion"; and a "rear pocket". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Art Unit: 3722

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "54" has been used to designate both a "securing tab" and a "flap". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

8. Claims 5, 15 and 19 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Dependent Claims 5, 15 and 19 are directed to a system which is not disclosed in the independent claims 1, 11 and 17.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3722

9. Claims 1-6, 11-22 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 1 recites the limitations: "the inner surface" in line 4; "the top" in line 6; "the area" in lines 7 and 10; and "the frame coating" in line 13. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 2 recites the limitations: "the upper edge" in line 2; and "the binding" in line 3. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 5 recites the limitation "A system...as defined in Claim 1" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 1 does not disclose a system of any kind.

13. Claim 11 recites the limitations: "the inner surface" in line 4; "the top" in line 6; and "the area" in line 7. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 13 recites the limitations: "the upper edge" in line 2; and "the binding" in line 3. There is insufficient antecedent basis for this limitation in the claim.

15. Claim 15 recites the limitation "A system...as defined in Claim 11" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 11 does not disclose a system of any kind.

16. Claim 17 recites the limitations: "the inner surface" in line 4; "the top" in line 6; and "the area" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3722

17. Claim 18 recites the limitations: "the upper edge" in line 2; and "the binding" in line 3.

There is insufficient antecedent basis for this limitation in the claim.

18. Claim 19 recites the limitation "A system...as defined in Claim 17" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 17 does not disclose a system of any kind.

19. Claim 21 recites the limitations: "the inner surface" in line 4; "the flexibility" in line 5; and "the area" in line 7. There is insufficient antecedent basis for this limitation in the claim.

20. Claim 22 recites the limitations: "the inner surface" in line 4; "the cover" in line 5; and "the area" in line 7. There is insufficient antecedent basis for this limitation in the claim.

21. Claim 24 recites the limitations: "the inner surface" in line 5; "the top" in line 7; and "the area" in line 8. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



Art Unit: 3722

22. Claims 1-5, 11-22 and 24, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al (6,206,602) in view of Wilson (5,590,911) and further in view of Wyant (4,991,767).

Yamamoto et al discloses in Fig. 2, a binder assembly comprising: front and rear plastic covers (12), wherein the front cover is transparent with an opaque frame (22); and an inner pocket (26) secured to the inner surface (12A) of the front cover (Col. 2, lines 60-65), permitting quick insertion of visual material information (65-67) from a top (28) of the inner areas of the pocket.

However, Yamamoto et al does not disclose a binder assembly having: transparent dividers with tabs which are mounted in the binder.

Wilson discloses in Fig. 7 and 8, a binder assembly having mounted dividers with tabs.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly to include mounted dividers as taught by Wilson for the purpose of organizing sheet information placed in the ring binder.

However, Yamamoto et al as modified by Wilson does not disclose an inner pocket secured along its outer edges and bottom edge; and a partial pocket extending half the area of a rear cover and formed of the same sheet as the rear cover, with the pocket being folded upward and bonded, and wherein the rear cover is coated with opaque material.

Wyant discloses in Fig. 1, 3, and Col. 1, lines 5-10, an assembly which could be a binder assembly comprising a rear pocket (47) having a folded up first area (36) and a folded down

Art Unit: 3722

second area (lower portion of 42) to secure the pocket in its folded position, wherein the pocket is secured along its outer edges.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly to include a pocket formed with a folded up first portion and a folded down second portion as taught by Wyant for the purpose of providing a more securely reinforced pocket.

In regards to **Claim 1**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include any type of desirable material on the cover and pocket, whether it is transparent or opaque, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claim 24**, it is notoriously well known in the art to print out visual display information previously constructed and displayed on a computer.

23. Claim 6, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al and Wilson in view of Wyant and further in view of Brown et al (6,364,559).

Yamamoto et al as modified by Wilson and Wyant disclose a binder assembly comprising all the elements as claimed in Claim 1, and as set forth above.

Art Unit: 3722

However, Yamamoto et al does not disclose a plurality of slits in a rear partial pocket for mounting cards.

Brown et al discloses in Fig. 5, a binder assembly comprising a partial pocket (45) having slits (53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamamoto et al's binder assembly to include pockets having slits as taught by Brown et al for the purpose of holding business cards.

In regards to Claim 6, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the partial pocket on desired cover, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

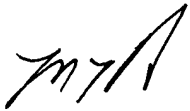
### ***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Conley, Jr., Sapienza et al, Bromer et al, Lehmann et al, Mayer, Welt, Ong, Abbott, Pitts, Etheredge, Wilson, Piotroski, Wien et al, Joe et al, Rossetto et al, Conklin et al disclose binder assemblies.

Art Unit: 3722


**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

August 9, 2002



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